

Application No. 10/087,718
Amendment "I" dated April 5, 2005
Reply to Office Action mailed February 15, 2005

REMARKS

Applicants and Applicants' attorney express appreciation to the Examiner for the courtesies extended during the recent interview held on March 29, 2005. Reconsideration and allowance for the above-identified application are now respectfully requested. Claims 1-35 and 39-41 are pending, wherein claims 1, 13, 18 and 26 have been amended, claims 36-38 were cancelled, and new claims 39-41 were added.

The Office Action rejects claims 1-5 under 35 U.S.C. § 102(b) as being anticipated by Schiffer et al. (U.S. 2002/0098341). Preliminarily, Applicants note that the publication date of Schiffer et al. (July 25, 2002) is subsequent to the filing date of the present application (March 1, 2002), such that Schiffer et al. is only citable under 35 U.S.C. § 102(e). Applicants therefore reserve the right to establish an earlier invention date in order to remove Schiffer et al. as a reference.

Claim 1 has been amended in order to specify that the biodegradable thermoplastic composition used to form the sheet or film includes at least one stiff thermoplastic biodegradable polymer having a glass transition temperature greater than about 10° C and at least one soft thermoplastic biodegradable polymer having a glass transition temperature less than about 0° C. Support for compositions that include stiff and soft thermoplastic biodegradable polymers having the claimed glass transition temperatures is set forth in the application at page 18, line 1 – page 31, line 21.

As discussed during the Examiner Interview, Schiffer et al. neither teaches nor suggests a sheet or a film formed from a blend of stiff and soft thermoplastic biodegradable polymers as defined in claim 1. In fact, Schiffer et al. fails to disclose even one working example of a biodegradable polymer or polymer blend, let alone one comprising stiff and soft biodegradable

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polymers. Instead, Schiffer et al. is mainly directed to a method of manufacturing breathable films and laminates. As such, Schiffer et al. focuses mostly on the equipment and methods used to manufacture such films and laminates, rather than the composition. In view of the foregoing, Applicants submit that claims 1-5 are neither anticipated by, nor obvious over, Schiffer et al., alone or in combination with any other art of record.

The Office Action rejects claims 1-5 and 9-15 under 35 U.S.C. § 102(b) as being anticipated by Wu et al. (WO 02/42365). As discussed during the Examiner Interview, Wu et al. is not prior art under any subsection of 35 U.S.C. § 102. First of all, Wu et al. has a publication date of May 30, 2002, which is after the filing date of the above-identified application (*i.e.*, March 1, 2002). As such, Wu et al. is not prior art under either 35 U.S.C. § 102(a) or 102(b). It is also not prior art under 35 U.S.C. § 102(e) because it is not a published international application that designates the United States. According to 35 U.S.C. § 102(e), "an international application filed under the treaty defined in Section 351(a) shall have the effect for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 22(2) of such treaty in the English language" (emphasis added). Paragraph [81] on the front cover of Wu et al. lists many countries, but not the United States. Therefore, Wu et al. is not prior art and may not be cited against any of the claims of the present application. Moreover, Applicants submit that Wu et al. neither teaches nor suggests a film or sheet formed from a biodegradable thermoplastic composition comprising at least one soft thermoplastic polymer and at least one stiff thermoplastic polymer as defined in claim 1 as now amended.

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The Office Action rejects claims 1 and 6-8 under 35 U.S.C. § 103(a) as being unpatentable under Schiffer et al or Wu et al. As set forth above, claim 1 as amended is neither anticipated by nor obvious over Schiffer et al. or Wu et al. Moreover, Wu et al. is not prior art.

The Office Action rejects claims 16-38 under 35 U.S.C. § 103(a) as being unpatentable over Wu et al. Applicants repeat that Wu et al. is not prior art. Moreover, Wu et al. neither teaches nor suggest a sheet or film that is "textured by a knurled or embossing-type roller" as recited in claim 16. Moreover, the Office Action states that "Wu et al. is silent about claimed dead-fold and the protrusion of some filler particles" as in claims 16-18 and 32.

Finally, applicants have cancelled claims 36-38 as being substantially duplicative of other claims in the application. Instead, Applicants have added new claims 39-41 in order to claim specific blends used to manufacture sheets or films according to the invention. Support for claiming at least one stiff thermoplastic biodegradable polymer and at least one soft thermoplastic biodegradable polymer having the claimed glass transition temperatures has already been established with respect to claim 1. Support for use of an aliphatic-aromatic copolyester as a soft thermoplastic biodegradable polymer is set forth in the application at page 26, lines 14-16. Support for starch that is free of plasticizers and that retains a substantial portion of its crystallinity is set forth in the application at page 9, lines 12-16; page 25, lines 10-14; page 30, lines 14-23; and page 31, lines 9-17. Support for claiming starch that can act as a filler and/or stiff thermoplastic polymer and/or that imparts dead-fold to a film or sheet is found in the application at page 25, lines 10-14; page 30, lines 19-23; and page 40, lines 5 and 10-12. Support for the claimed dead-fold values of claims 40 and 41 are found in original claims 7 and 8, respectively. Schiffer neither teaches nor suggests a single layer sheet or a film formed from a biodegradable thermoplastic composition comprising an aliphatic-aromatic copolyester in

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combination with starch that is free of plasticizers and that retains a substantial portion of its crystallinity. Wu et al. is not prior art, nor does it teach or suggest a sheet or film having the specific blend of components recited in claim 39.

Finally, in view of the amendments made to various claims in the present application, Applicants wish to bring the following to the attention of the Examiner: U.S. Patent No. 6,572,340 to Khemani et al. and copending U.S. application Serial No. 10/087,256 to Khemani et al., both of which are commonly assigned with respect to the present application and have the same inventorship.¹

In view of the foregoing, Applicants believe the claims as now presented are in allowable form. In the event the Examiner wishes Applicants to file a Terminal Disclaimer with respect to the commonly owned patent and/or copending application referred to above, and/or in the event there remains any other impediment to the prompt allowance of this application, the Examiner is requested to initiate a telephonic interview with the undersigned attorney.

Dated this 10th day of April 2005.

Respectfully submitted,



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¹ Please be advised that inventorship for U.S. Patent No. 6,572,340 to Khemani et al. has been amended by petition to delete Per Just Andersen, Ph.D., as a named inventor.